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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/665,232	09/17/2003	Carlos Fernando Bella Cruz	END920000033US2 (13467Z)	6285
23389 7590 01/24/2007 SCULLY SCOTT MURPHY & PRESSER, PC 400 GARDEN CITY PLAZA SUITE 300 GARDEN CITY, NY 11530			EXAMINER ADE, OGER GARCIA	
			ART UNIT 3627	PAPER NUMBER

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	01/24/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/665,232	<b>Applicant(s)</b> CRUZ ET AL.	
	<b>Examiner</b> Garcia Ade	<b>Art Unit</b> 3627	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 06 November 2006.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 8, 9, 11, 12, 14, 15, 17 - 22 is/are pending in the application.
- 4a) Of the above claim(s) 1-7, 10, 13 and 16 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 8, 9, 11, 12, 14, 15, 17 - 22 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

**DETAILED ACTION**

***Response to Amendment***

1. The amended filed on November 6<sup>th</sup>, 2006 under 37 CFR 1.131 has been considered but is ineffective to overcome the Kalagnanam, Bye, and "Production Planning and Scheduling" (ACESITA) references.

***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

2. Claims 8, 9, 11, 12, 14, 15, and 17-22 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.
3. Claims 8, 9, 11, 12, 14, 15, and 17-22 are non-statutory because they are not concrete and tangible. No result or output is presented – rather data is just manipulated.

***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

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5. Claims 8,11,14 are rejected under 35 U.S.C. 102(e) as being anticipated by Kalagnanam et al. [6,044,361].

The applied reference has a common assignee with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.

Kalagnanam ('361) shows identifying orders from customers for finished units; identifying finished units available to fill order; identifying defects in the units and defects that the customers are willing to accept (col. 2, lines 27-33, 58-68); on the basis of the defects: identifying valid units that are available to orders; and iteratively assigning and unassigning the orders until all orders are filled or there are no more assignment option, wherein if no available unit fulfills an order, a previously assigned unit which fulfills the order is unassigned from its previous match and reassigned to the present order (cols. 4-6).

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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7. Claims 9, 12, 15, and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kalagnanam et al as applied to claims 8, 11, and 14 above, and further in view of Dye [4,459,663].

Kalagnanam shows all elements of the claims except identifying incomplete orders and due date and assigning units to the earliest orders. Dye shows these elements. It would have been obvious to one of ordinary skill in the art to further modify the method of Kalagnanam by identifying the date of orders and assigning items to the earliest orders in order to avoid missing a delivery date.

8. Claims 17 - 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kalagnanam et al..

Kalagnanam shows that the finished units are metallic units. It does explicitly show identifying for each of a group of orders the largest area of each of the units that can be assigned to the order.

However, the examiner takes official notice that it is notoriously old and well known in the art to do so. It would have been obvious to one of ordinary skill in the art to modify the method of Kalagnanam by identifying the largest area of the metallic units that can be assigned to the orders in order to reduce waste.

9. Claims 8, 11, 13, 14, and 16 - 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over "Production Planning and Scheduling" (ACESITA).

ACESITA shows identifying finished units and orders for those units; identifying valid finished units that are available to be assigned to the orders; and units to orders (see e.g., pgs. 22, and 42). ACESITA further shows identifying defects in the units; identifying defects the customers are willing to accept; and

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assigning units on that basis. (It is noted that ACESITA recites that the system "matches the relevant attributes of the material to the specification of the order and determines the eligibility of the material for a given order". It continues to state that factors such as "quality", or relative presence of defects, are considered in assigning the material to orders). ACESITA does not explicitly show iteratively assigning and unassigning in a defined sequence until all order are fulfilled or no options are left, wherein if no units are available to fulfill an order, a previously assigned valid unit is found and unassigned from the order to which was assigned.

However, the examiner takes official notice that it is notoriously old and well known in the art to do so. It would have been obvious to one of ordinary skill in the arts to modify the method of ACESITA by iteratively assigning and unassigning units to orders wherein if no units are available to fulfill an order, a previously assigned valid unit is found and unassigned from the order to which was assigned in order to ensure that all possible options are tested so that the most efficient option can be used.

As to claims 17 - 19, ACESITA shows that the finished units are metallic units and applying the units to the orders according to business rules. It does explicitly state that one of the business rules is to identify the largest portion of metallic units that can be assigned to an order.

However, the examiner takes official notice that it is notoriously old and well known in the art to do so. It would have been obvious to one of ordinary skill in the art to further modify the method of ACESITA by identifying the largest area of the metallic units that can be assigned to the orders in order to reduce waste.

***Response to Arguments***

10. Applicant's arguments filed on November 6<sup>th</sup>, 2006 have been fully considered but they are not persuasive.

A) Regarding the 35 USC 101 rejection, the examiner finds Applicants' arguments persuasive in light of the amendment. However, it is noted that the invention is not concrete and tangible because it produces no claimed output.

B) Regarding the 103 rejection, Applicants argue that ACESITA does not disclose "when it is necessary to unassign and assigned unit order to satisfy a given order, identifying the smallest order that can be unassigned to satisfy that given order". The examiner disagrees. In Applicants' description of the present invention, it is noted that some of the elements argued are not claimed (e.g., when it is necessary to unassign and assigned unit order). Applicants further argue that ACESITA does not disclose "the allocation and reallocation of orders to precise regions of coils so that the minimum quality of an order is not violated while minimizing waste of material". In Applicants' description of the present invention, it is noted that some of the elements argued are not claimed (e.g., reallocation). It is noted that the ACESITA document shows an inventory reallocation function.

***Conclusion***

11. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is

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filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Garcia Ade whose telephone number is 571.272.5586. The examiner can normally be reached on M-F 8:30AM - 5PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Florian Zeender can be reached on 571.272.6790. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

13. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to



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the automated information system, call 800-786-9199 (IN USA OR CANADA) or  
571-272-1000.

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